

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-11 and 15-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no support for the limitation “the unique discrete identification created by fluorescent material...is visible at an acute angle to the object surface without...any intermediary layer between the viewer and the at least one paint layer”. Although the specification does not exemplify the use of an intermediary layer, the specification does not convey to one of ordinary skill in the art that Applicants had possession of a necessary absence of an intermediary layer. The mere absence of a positive recitation is not basis for an exclusion (MPEP 2173.05(i)).

### ***Response to Arguments***

3. Applicant’s arguments, see pg. 13-17, filed 12/15/2008, with respect to claims 1-11 and 15-23 have been fully considered and are persuasive. The 35 U.S.C. 103(a) rejections of the claims have been withdrawn.

4. Applicant's arguments filed 12/15/2008 have been fully considered but they are not persuasive.

Applicant argues on pg. 13 that no new matter has been added. However, the specification does not support the limitation of “the unique discrete identification created by fluorescent material...is visible at an acute angle to the object surface without...any intermediary layer between the viewer and the at least one paint layer”. Although the specification does not exemplify the use of an intermediary layer, the specification does not convey to one of ordinary

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skill in the art that Applicants had possession of a necessary absence of an intermediary layer. The mere absence of a positive recitation is not basis for an exclusion (MPEP 2173.05(i)). Thus, the amended claims present new matter.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Patel et al. (U.S. Publication No. 2004/0037947) teaches a white glossy toner mark visible at only about 10 to about 85 degrees to an angle normal to the surface [0002].

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy Lin whose telephone number is (571)272-8902. The examiner can normally be reached on Monday thru Friday 8AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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